DETAILED ACTION

Response to Amendment

1.   The amendment filed June 12, 2009 has cancelled no claims. Claims 1, 23, and

39 were amended and no new claims were added. Thus the currently pending claims in

the application are 1, 8-12, 19-23, 30-34, and 36-44.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1, 10-12, 21-23, 32-34, and 37-40 rejected under 35 U.S.C. 102(b) as

being anticipated by Roth et al. (WO 98/34189).

Claims 1, 12 and 23:   Roth discloses an advertisement opportunity trading system,

method and a market control server that includes a plurality of sponsors, said

system enabling communication between a terminal of one of the plurality of

sponsors of an advertisement and a terminal of media which distributes an

advertisement via a communication network that is communicatively connected to a

plurality of terminals of the plurality of sponsors, respectively, in or to intermediate

between one of the plurality of sponsors and the media for facilitating a trade for an

advertisement opportunity offered by the media, said system and server comprising:

a.   An advertisement data reception unit which receives advertisement data from

the one of the plurality of sponsors who wants the advertisement data to be

distributed on an advertisement opportunity, the advertisement data including

genre data describing a genre of the advertisement. (Page 6, line 17 through

Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line

26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines "genre" as a

"kind, or sort" in relation to a particular style, form or content. In the section

cited, Roth discloses the ability of a site to define the type of advertising

content that it is willing to accept, such as java, gif, or file size. Additionally,

Roth discloses that ad selection may be based upon CT (Content type) which

would also be considered genre data of the advertisement)

b.   An advertisement opportunity reception unit which receives an advertisement

opportunity offered by media that includes prohibited genre data designating

a genre of advertisement that will not be permitted for the advertisement

opportunity. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line

26)

c.   An advertisement data check unit that checks whether the genre data of the

advertisement data corresponds to the prohibited genre data of the

advertisement opportunity and notifies a result of said checking to the media.

(Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)

d.		A distribution accepting unit which accepts an application for distribution of the advertisement data from the one of the plurality of sponsors only after receiving information from the media representing that distribution of the advertisement data is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20 line 16; and Page 22, lines 1-9)

e.		A trade process unit which performs a process for trading the advertisement opportunity based on the application accepted by said distribution accepting unit. (Page 6, line 17 through Page 7, line 15)

f.		An advertisement data registration unit which registers the advertisement data received by said advertisement data reception unit. (Page 6, line 17 through Page 7, line 15)

g.		An advertisement opportunity registration unit which registers the advertisement opportunity received by said advertisement opportunity reception unit. (Page 6, line 17 through Page 7, line 15)

h.		An advertisement opportunity publicizing unit which publicizes information on the advertisement opportunity registered in said advertisement opportunity registration unit via said communication network, wherein said distribution accepting unit accepts an application for distribution of the advertisement data registered in said advertisement data registration unit from the sponsor. (Page 6, line 17 through Page 7, line 15)

i.		Wherein in a case where said distribution accepting unit accepts applications for distribution of advertisement data from others of the plurality of sponsors

for a same advertisement opportunity, said trade process unit puts up the

advertisement opportunity for auction. (Page 6, line 17 through Page 7, line

15)

j.   A plurality of advertisement data can be registered by any of the plurality of

sponsors in said advertisement data registration unit for one advertisement

opportunity. (Page 23, line 8 through Page 24, line 1)

k.   In a case where the media determines that the plurality of advertisement data

of the one of the plurality of sponsors are appropriate for distribution on the

one advertisement opportunity, said distribution accepting unit accepts an

application for distribution of one advertisement data designated by the one of

the plurality of sponsors from the plurality of advertisement data, as one to be

actually distributed. (Page 23, line 8 through Page 24, line 1)

l.   Wherein said advertisement data reception unit changes the advertisement

data designated by the one of the plurality of sponsors as one to be actually

distributed with another advertisement data among the plurality of

advertisement data in accordance with an instruction from the one of the

plurality of sponsors. (Page 26, line 6 through Page 27, line 2)

Claim 23: Roth discloses an advertisement opportunity trading method which

enables communication between a terminal of one of a plurality of sponsors of an

advertisement and a terminal of media which distributes an advertisement via a

communication network, in order to intermediate between the one of a plurality of

sponsors and the media for facilitating a trade for an advertisement opportunity offered by the media, in which the communication network is communicatively connected to a plurality of terminals of the plurality of sponsors, respectively, said method comprising:

a. Receiving advertisement data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity, the advertisement data including genre data describing a genre of the advertisement. (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines "genre" as a "kind, or sort" in relation to a particular style, form or content. In the section cited, Roth discloses the ability of a site to define the type of advertising content that it is willing to accept, such as java, gif, or file size. Additionally, Roth discloses that ad selection may be based upon CT (Content type) which would also be considered genre data of the advertisement)

b. Receiving an advertisement opportunity offered by media, the advertising opportunity including a prohibited genre data designating a genre of advertisement that will not be permitted for the advertisement opportunity. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)

c. Checking whether the genre data of the advertisement data corresponds to the prohibited genre data of the advertisement opportunity and notifying a result of said checking to the media. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)

d. Accepting an application for distribution of the advertisement data from the

sponsor only after receiving information from the media representing that

distribution of the advertisement data is appropriate for the advertisement

opportunity. (Page 6, line 17 through Page 7, line 15; Page 20 line 16; and Page

22, lines 1-9)

e. Performing a trading process for trading the advertisement opportunity based on

the application accepted in said receiving information and accepting an

application. (Page 6, line 17 through Page 7, line 15)

f. Registering the advertisement data received in said receiving advertisement

data. (Page 6, line 17 through Page 7, line 15)

g. Registering the advertisement opportunity received in said receiving an

advertisement opportunity. (Page 6, line 17 through Page 7, line 15)

h. Publicizing information on the advertisement opportunity registered in said

registering the advertisement opportunity via said communication network. (Page

6, line 17 through Page 7, line 15)

i. Accepting an application for distribution of the advertisement data registered in

said registering the advertisement data from the one of a plurality of sponsors in

said receiving information. (Page 6, line 17 through Page 7, line 15; Page 20 line

16; and Page 22, lines 1-9)

j. Receiving applications for distribution of advertisement data from more than one

of the plurality of sponsors for a same advertisement opportunity; thereafter,

putting the advertisement opportunity up for auction in said performing a trading

process. (Page 6, line 17 through Page 7, line 15; Page 20 line 16; and Page 22, lines 1-9)

k. Registering a plurality of advertisement data by the one of the plurality of sponsors in said registering the advertisement data for one advertisement opportunity. (Page 23, line 8 through Page 24, line 1)

l. Accepting and distributing, in a case where the media determines that the plurality of advertisement data of the one of the plurality of sponsors are appropriate for distribution on the one advertisement opportunity, an application for distribution of one advertisement data designated by the one of the plurality of sponsors from the plurality of advertisement data as one to be actually distributed in said receiving information. (Page 23, line 8 through Page 24, line 1)

m. Receiving an instruction provided in said receiving advertisement data output from the one of the plurality of sponsors and changing the advertisement data designated by the one of the plurality of sponsors as one to be actually distributed with another advertisement data among the plurality of advertisement data in accordance with the instruction output from the one of the plurality of sponsors provided in said receiving advertisement data. (Page 26, line 6 through Page 27, line 2)

Claims 10, 11, 21, 22, 32, and 33:   Roth discloses the advertisement trading system, method and market control server according to claims 1, 12, and 23 respectively, further comprising an advertisement data mirroring unit which transmits

advertisement data which is determined as appropriate for distribution by the media

to an advertisement distribution controller which performs distribution of

advertisement data, wherein:

a. Said advertisement data mirroring unit transmits the advertisement data to said

advertisement distribution controller before a trade for an advertisement

opportunity is started by said trade process unit. (Page 23, line 8 through Page

24, line 1)

b. Said advertisement distribution controller stores the transmitted advertisement

data, and performs distribution of the stored advertisement data which is toe be

distributed on an advertisement opportunity, in a case where a contract for the

advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 34: Roth discloses a computer-readable recording medium which stores a

program for controlling a computer to function as:

a. Advertisement data receiving means for receiving advertisement data from one

of a plurality of sponsors who wants the advertisement data to be distributed on

an advertisement opportunity, the advertisement data including genre data

describing a genre of the advertisement. (Page 6, line 17 through Page 7, line

15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Fig. 5B,

517) (The Merriam-Webster dictionary defines "genre" as a "kind, or sort" in

relation to a particular style, form or content. In the section cited Roth discloses

the ability of a site to define the type f advertising content that it is willing to

accept, such as java, gif, or file size. Additionally, Roth discloses that ad

selection may be based upon CT (Content type) which would also be considered

genre data of the advertisement)

b. Advertisement data registering means for registering the advertisement data

received by said advertisement data receiving means. (Page 6, line 17 through

Page 7, line 15)

c. Advertisement opportunity receiving means for receiving an advertisement

opportunity offered by media, the advertisement opportunity including prohibited

genre data designating a genre of advertisement that will not be permitted for the

advertisement opportunity. (Page 8, lines 1-11; and Page 19, line 27 through

Page 20, line 26)

d. Advertisement opportunity registering means for registering the advertisement

opportunity received by said advertisement opportunity receiving means. (Page

6, line 17 through Page 7, line 15)

e. Advertisement opportunity publicizing means for publicizing information on the

advertisement opportunity registered by said advertisement opportunity

registering means via said communication network. (Page 6, line 17 through

Page 7, line 15)

f. Advertisement data check means that checks whether the genre data of the

advertisement data corresponds to the prohibited genre data of the

advertisement opportunity and notifies a result of said checking to the media.

(Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)

g. Distribution accepting means for accepting an application for distribution of the advertisement data from the one of the plurality of sponsors only after receiving information from the media representing that distribution of the advertisement data is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20, line 16, and Page 22, lines 1-9)

h. A trade processing means for performing a process for trading the advertisement opportunity based on the application accepted by said distribution accepting means. (Page 6, line 17 through Page 7, line 15)

i. Wherein determining that the advertisement is appropriate for the advertisement opportunity comprises:

    a. Designating means for designating one advertisement data out of a plurality of advertisement data registered by the one of the plurality of sponsors for one advertisement opportunity as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)

    b. Wherein the advertisement data designated by the one of the plurality of sponsors as one to be actually distributed is changed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the one of the plurality of sponsors. (Page 26, line 6 through Page 27, line 2)

Claim 37: Roth discloses the computer-readable recording medium according to claim 34, storing a program for controlling a computer to further function as:

a.   Advertisement data mirroring means for transmitting advertisement data

which is determined as appropriate for distribution by the media to

advertisement distribution controlling means for performing distribution of

advertisement data before a trade for an advertisement opportunity is started

by said trade processing means. (Page 23, line 8 through Page 24, line 1)

b.   Advertisement distribution controlling means for storing the transmitted

advertisement data and performing distribution of the stored advertisement

data which is to be distributed on an advertisement opportunity, in a case

where a contract for the advertisement opportunity is settled. (Page 23, line 8

through Page 24, line 1)

Claims 38, 39 and 40:   Roth discloses an advertisement trading and distribution

control apparatus, method and computer-readable medium which provides

information and an advertisement data to a terminal of an audience, said apparatus,

method, and computer readable medium comprising:

a.   A trade process unit for performing a trading of an advertisement opportunity

offered by a media in connection with advertisement data from one of a

plurality of sponsors, said advertisement data to be distributed on the

advertisement opportunity to the terminal of the audience, the advertisement

data including genre data describing a genre of the advertisement. (Page 6,

line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through

Page 20, line 26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines

"genre" as a "kind, or sort" in relation to a particular style, form or content. In the section cited Roth discloses the ability of a site to define the type f advertising content that it is willing to accept, such as java, gif, or file size. Additionally, Roth discloses that ad selection may be based upon CT (Content type) which would also be considered genre data of the advertisement)

b.   Advertisement data check means that checks whether the genre data of the advertisement data corresponds to prohibited genre data of an advertisement opportunity and notifying to a media that offers the advertisement opportunity said result of checking. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)

c.   Distributing means for distributing the advertisement data to said terminal of an audience from a market control server which intermediated between the one of the plurality of sponsors of the advertisement data and the media only after receiving information from the media representing that distribution of the advertisement is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20, line 16; and Page 22, lines 1-9)

d.   Storing means for receiving advertisement data to be provided to the terminal of the audience from said market control server, and storing the received advertisement data, wherein said distributing means starts distributing the advertisement data stored in said storing means to said terminal of an

audience from a time set for the advertisement opportunity. (Page 6, line 17

through Page 7, line 15)

e.   Wherein determining that the advertisement is appropriate for the

advertisement opportunity comprises:

a.   Designating means for designating one advertisement data out of a

plurality of advertisement data registered by the one of the plurality of

sponsors for one advertisement opportunity as one to be actually

distributed. (Page 23, line 8 through Page 24, line 1)

b.   Wherein the advertisement data designated by the one of the plurality of

sponsors as one to be actually distributed is changed with another

advertisement data among the plurality of advertisement data in

accordance with an instruction from the one of the plurality of sponsors.

(Page 26, line 6 through Page 27, line 2)

Claims 41, 42, 43, and 44: The advertisement opportunity trading system, the

market control server, the advertisement opportunity trading method, and the

computer readable medium, according to claims 1, 12, 23, and 34 respectively,

wherein the advertisement data registration unit stores an advertisement data ID as

part of the advertisement data in a market-use advertisement data storage unit via

an advertisement data mirroring unit, wherein the advertisement data registration

unit attaches an advertisement data name and the genre data representing a genre

of the advertisement data which are inputted from an input unit of the sponsor-side

terminal to the advertisement data stored in the market-use advertisement data

storage unit, and wherein the advertisement data registration unit registers the

advertisement data name and the genre data as part of the advertisement data.

(Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27

through Page 20, line 26; and Page 23, line 8 through Page 24, line 1) (Note that the

cited sections indicate that advertisements are place in a database (registered) and

must include an advertisement data identification number as per Page 23, line 8

through Page 24, line 1, where the stored advertisement is identified by its ad index

in the database.)

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 8, 9, 19, 20, 30, 31, and 36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Roth et al. (WO 98/34189).

Claims 8, 9, 19, 20, 30, 31, and 36:   Roth discloses the advertisement opportunity

trading system according to claims 1, 12, 23, and 34 respectively. In the teachings

of Roth, an advertiser creates form objects when bids are proposed. The fields in

these form objects contain limitations and restrictions the advertiser specifies

regarding ad placement (Page 27, line 4 through Page 28, line 6). While Roth does

not explicitly disclose that these form objects are used to perform a competition

check, so that advertisements from the same business category are not displayed

simultaneously, Official Notice is taken that it is old and well known that advertisers

place restrictions upon media outlets regarding the placement of competitive

advertisements. If Ford were to purchase advertising space on a web page, they

would not want an adjacent advertisement from a competitor such as General

Motors to be displayed on the web page at the same time. Displaying competitive

advertisements in this manner erodes the effectiveness of both companies

advertising campaigns. Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to incorporate criteria

allowing such restrictions. One would have been motivated to accommodate

advertiser restrictions in order to generate wide scale acceptance and use of the

automated bidding system and to help advertiser's maximize the effectiveness of

their advertising budgets.

Response to Arguments

6.   Applicant's arguments filed June 12, 2009 have been fully considered but they

are not persuasive.

        a.   The applicant argues that the claims of the current invention require that

        application for distribution for an advertisement opportunity are accepted before

the advertisement is put up for auction and asserts that this order of operation

does not occur in the teachings of Roth. The applicant relies on the statement of

the current claims that recites "wherein in a case where said distribution

accepting unit accepts applications for distribution of advertisement data from a

plurality of sponsors for a same advertisement opportunity, said trade process

unit puts up the advertisement opportunity for auction. The examiner disagrees

that the limitations imposed by such a statement requires such an order of

operation. The Examiner has determined that the "wherein" clause is considered

an optional feature in the claim and is given little or no weight as per MPEP

2111.04. The claims are directed towards communication between **one of a**

plurality of sponsors and **a terminal** of media which distributes an

advertisement via a communication network, in order to intermediate between

the one of a plurality of sponsors and the media for facilitating a trade for an

advertisement. Thus, the claim does not require that there be more than one

sponsor communicating. Instead, while a plurality of sponsors are involved in the

system only a single sponsor is claimed as communicating with the media.

However, in order to further the prosecution of the case the examiner points out

that Roth discloses sending advertisements that a sponsor would like to display

when an opportunity arises to a central server (advertisement data reception unit)

(Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; and Page 35, lines

13-25). Note that the submission of advertisements to the advertising database

(which is considered the advertisement data registration unit) can occur before

an advertisement opportunity presents itself and are accepted because they are

placed in a database from which the advertisements are selected when the

auction begins (Page 3, lines 1-10). Roth further discloses receiving an

advertisement opportunity (advertisement opportunity reception unit) which

contains various criteria regarding the type of advertisements that may be

provided (advertisement opportunity registration data) and forwarding it from the

view server (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26).

The advertisement data is checked regarding genre data (advertisement data

check unit) (Page 8, lines 1-11; and Page 19, lines 27 through Page 20, line 26).

Note that both the media presenting an opportunity and the bidder requesting an

advertisement to be displayed can place limitations regarding the

appropriateness of an advertisement for display (Page 20, line 16 discloses a

genre limitation imposed by the site while Page 2, line 6 through Page 28, line 6

discloses such limitations imposed the advertiser). Roth further discloses that

the view server send the view op to bidding agents who evaluate the given

criteria for the advertiser and the view op to determine if a match can be made

(Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 12, line 19

through Page 13, line 2; Page 13, lines 13-23; and Page 22, lines 1-9). If a

match can be made, then distribution is accepted and the trade process begins

and bids are submitted back to the view server (Trade Process Unit) (Page 6,

line 17 through Page 7, line 15; Page 8, lines 1-11; Page 12, line 19 through

Page 13, line 2; Page 13, lines 13-23; and Page 22, lines 1-9). Finally, bids are

accepted from various bidding agents and an auction process occurs wherein a determination is made regarding the winning bid. (Page 23, line 8 through Page 24, line 1). Thus, Roth does teach the specified order set forth in the clients arguments. The above explanation also points out where, in Roth, the advertisement data that is to be distributed is registered, as requested by the applicant.

b.   The applicant argues that Roth does not register the advertisement data. However, Roth disclose on Page 3, lines 1-10 that advertisements are received and stored. Thus the advertisements have been accepted and registered. Roth further discloses that the advertisements are identified by an ad index number when the bids are received and the winning bid is selected on Page 23, lines 21-23. The storing and indexing of the ads is a form of registering the advertisement data. Thus, the limitations of the claims as currently written have been satisfied. The examiner suggests amending the claim to specifically point out and distinctly claim the applicant's registration process.

c.   The applicant argues that Roth does not disclose putting an advertisement opportunity up for auction. However, the transmitting of the view-op object to the bidding agents is putting the advertisement opportunity up for auction, since bids are then received and a selection of the highest bidder is determined (Page 23, lines 8-20)

d.   The applicant argues that there is no other way to recite the features of

the system claims without using "wherein" clauses and as such the features

should be given patentable weight. According to MPEP 2101.04, the examiner

must make a determination regarding whether or not a "wherein" clause imposes

a limitation on the claim based on the facts of the case. In the instant case, the

claims are directed towards communication between **one of a plurality of**

sponsors and **a terminal** of media which distributes an advertisement via a

communication network, in order to intermediate between the one of a plurality of

sponsors and the media for facilitating a trade for an advertisement. Thus, the

claim does not require that there be more than one sponsor communicating.

Instead, while a plurality of sponsors are involved in the system only a single

sponsor is claimed as communicating with the media. Thus the examiner has

determined based upon the facts of the case that that the "wherein" clause is

considered an optional feature in the claim and is given little or no weight as a

limiting feature of the claim. The examiner suggest amending claim to indicate

that communication is occurring between one or more of a plurality of sponsors

and that advertisements are received and accepted from one or more of a

plurality of sponsors.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHN VAN BRAMER whose telephone number is

(571)272-8198. The examiner can normally be reached on 6am - 4pm Monday

through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax

phone number for the organization where this application or proceeding is assigned

is 571-273-8300.

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272-1000.

/John Van Bramer/
John Van Bramer
Examiner, Art Unit 3622